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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/729,517
Filing Date: December 05, 2003
Appellant(s): OXMAN ET AL.

David G. Miranda
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/19/2009 appealing from the Office action mailed 02/12/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1 – 3, 5 – 24, and 26 – 31.

Claims 4, and 25 been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2001/0047326 A1	BROADBENT	11-2001
2002/0188540 A1	FAY	6-2001
2001/0051906 A1	ESPOSITO	5-2001
2004/0064404 A1	COHEN	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 – 3, 5 – 24, 26, and 28 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent et al. (Broadbent hereinafter) (US Patent App. Pub. 2001/0047326 A1, published: November 29, 2001), in view of Fay et al. (Fay hereinafter) (US Patent App. Pub. 2002/0188540 A1, filed: June 8, 2001), and further in view Esposito (US Patent App. Pub. No. 2001/0051906 A1, filed May 1, 2001).

Regarding Claim 1, Broadbent discloses a computerized system for producing a domestic relations order comprising:

a receiver for receiving information (Figure 4A, item 401, Page 9, [0123], lines 3 – 8, Broadbent¹). However, Broadbent does not expressly disclose a domestic relations order. On the other hand, Fay discloses a receiver for receiving information relating to a domestic relations order (Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8;

respectively, Fay). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Fay's teachings to the system of Broadbent. Skilled artisan would have been motivated to do so, as suggested by Fay (Page 2, [0012] and [0014], lines 1 – 3 and 3 – 5; respectively, Fay), to provide a user with a plurality of periodic retirement income payments; and to provide a defined retirement benefit which will guarantee an individual a minimum defined income level upon individual's retirement. In addition, both of the references (Broadbent and Fay) teach features that are directed to analogous art and they are directed to the same field of endeavor of database management system, such as, authorization, results creation based on received information, and rules module. This relation between both of the references highly suggests an expectation of success.

The combination of Broadbent in view of Fay furthermore discloses that:

said information comprising an alternate payee (Figure 22, "Married to (which co-borrower)", Broadbent).

However, the combination of Broadbent in view of Fay is silent with respect to court information. On the other hand, Esposito discloses a system similar to the combination of Broadbent in view of Fay's including: court information (Page 1, [0008], lines 5 – 7 and 21 – 29; Esposito).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Esposito's teachings to the system the combination of Broadbent in view of Fay. Skilled artisan would have been motivated to

¹ Wherein examiner interprets information, such as, input borrower, property and originator date as the

do so, as suggested by Esposito (Page 1, [0008], lines 14 – 19 and 23 – 25, Esposito), to offer a simplified compliance with federal and state rules (through an artificial intelligence that can identify a particular event that has occurred with respect to a particular employee benefit plan, and a particular employee who must receive a particular document and in what manner and when); and to avoid potential penalties assessed by a federal court or government agency for non-compliance. In addition, the applied references (Broadbent, Fay, and Esposito) teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, databases management systems, compliance rules for documents, and employee benefit plans. This close relation between the applied references highly suggests an expectation of success.

Furthermore, the combination of Broadbent in view of Fay and further in view of Esposito discloses:

a rules engine in communication with the receiver for selecting sample text passages (Page 9, [0120], lines 10 – 17, Broadbent; and Page 6, [0068], lines 14 – 25, Esposito); and

a document assembler for automatically incorporating a first subset of the sample text passage (Page 9, [0120], lines 10 – 17, Broadbent; and Page 6, [0068], lines 14 – 25, Esposito) and a second subset of the received information comprising the alternate payee (Figure 22, “Married to (which co-borrower)”, Broadbent) and the court information into a court-compliant domestic relations order for submission to a court

information relating to a domestic relation order claimed.

(Figure 18, “loan programs that fit the criteria you entered on the previous pages”, Page 10, [0125], lines 5 – 9, Broadbent²; Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay; and Page 1, [0008], lines 8 – 13, Esposito).

Regarding Claim 2, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein a subset of the received information comprises information associated with a participant in an employee benefit plan (Page 7, [0096], lines 7 – 9, employment agreement, Broadbent; and Page 1, [0008], lines 8 – 13, Esposito).

Regarding Claim 3, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein, received information comprises information associated with a legal representative of the participant (Figure 30, “Welcome, Joe Realtor”, Page 7, [0097], lines 1 – 7, Broadbent ;and also see Page 7, [0094], lines 9 – 16, “(5) document preparation fee payable to the lender and passed through to third-party vendor; (6) tax related service fee payable to the lender and passed through to third-party vendor; and (7) attorney fee payable to lender and passed through to closing attorney. Applicants will charge a lender a membership fee to participate in Applicant's Program and a flat fee for each Completion Certificate issued to the lender.”; Broadbent).

² Wherein the step of displaying specific loan programs (as in Figure 18, Broadbent) corresponds to the

Regarding Claim 5, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein, the received information comprises information associated with a legal representative of the alternate payee (Figure 30, Page 7, [0097], lines 1 – 7, Broadbent ;and also see Page 7, [0094], lines 9 – 16, “(5) document preparation fee payable to the lender and passed through to third-party vendor; (6) tax related service fee payable to the lender and passed through to third-party vendor; and (7) attorney fee payable to lender and passed through to closing attorney. Applicants will charge a lender a membership fee to participate in Applicant's Program and a flat fee for each Completion Certificate issued to the lender.”; Broadbent).

Regarding Claim 6, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system further including a data storage device for storing rules relating to a domestic relations order (Page 4 and 16, [0051] and [0202], lines 1 – 6 and 1 – 3; respectively, Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay).

Regarding Claim 7, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein the data storage device further stores sample text passages (Figure 5 and 22, item 543 and “save” in Figure 22, Page 20, [0219], lines 17 – 22; respectively, Broadbent).

Regarding Claim 8, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein the sample text passages relate to a domestic relations order (Figure 5 and 22, item 543 and “save” in Figure 22, Page 20, [0219], lines 17 – 22; respectively, Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay).

Regarding Claim 9, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein the rules engine further selects a first subset of the sample text passages based, at least in part, on the stored rules (Page 9, [0120], lines 10 – 17, Broadbent; and Page 6, [0068], lines 14 – 25, Esposito).

Regarding Claim 10, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein the rules engine further selects a first subset of the sample text passages based, at least in part, on the received information (Figure 18, “loan programs that fit the criteria you entered on the previous pages”, Page 10, [0125], lines 5 – 9, Broadbent³; and Page 6, [0068], lines 14 – 25, Esposito).

Regarding Claim 11, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein the document assembler receives additional information from the data storage device, the additional information having

been previously included in a domestic relations order (Page 13, [0177], lines 8 – 13, the previous ‘override’ application, Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay).

Regarding Claim 12, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system further comprising an administrative module for maintaining the rules engine (Page 4, [0051], lines 1 – 4, Broadbent).

Regarding Claim 13, the combination of Broadbent in view of Fay and further in view of Esposito discloses a computerized method for producing a domestic relations order, comprising:

providing a plurality of sample text passages relating to domestic relations orders (Figure 23, “1234 any Street”, Broadbent⁴; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay), the sample text passages including embedded parameters (Figure 23, Current Street Address, Broadbent⁵) comprising an alternate payee Figure 22, “Married to (which co-borrower)”, Broadbent) and court information (Page 1, [0008], lines 5 – 7 and 21 – 29; Esposito);

requesting information for inclusion into a domestic relations order (Figure 24, Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively,

³ Wherein the step of displaying specific loan programs (as in Figure 18, Broadbent) corresponds to the step of selecting a subset of the sample text passages claimed.

⁴ Wherein “1234 any Street” corresponds to the sample text passage claimed. In addition, the text that would be entered in the text box (Figure 29, Broadbent) corresponds to another sample text passage claimed.

Fay), the requested information including values for one or more of the embedded parameters (Figure 24, item showing value “ \$15000”, Page 21, [0238], lines 1 – 3, Broadbent⁶);

receiving the requested information (Figure 4A, item 401, Page 9, [0123], lines 3 – 8, Broadbent⁷); and

automatically assembling court-compliant domestic relations order (Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay) for submission to a court using a first subset of the sample text passages (Page 9, [0120], lines 10 – 17, Broadbent; and Page 6, [0068], lines 14 – 25, Esposito) and a second subset of the requested information (Figure 4D, items 482 and 483, Page 10, [0125] and [0126], lines 14 – 17 and 18 – 21; respectively, Broadbent⁸; and Page 1, [0008], lines 8 – 13, Esposito).

Regarding Claim 14, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising receiving the requested information over an electronic communications network (Figure 1, item 100, typical internet network configuration, Page 8, [0116], lines 1 – 7, Broadbent).

⁵ Wherein “Current Street Address” corresponds to the embedded parameter claimed.

⁶ Wherein the value “\$1500” corresponds to the value claimed; and “Estimated Property Value” corresponds to the parameter claimed.

⁷ Wherein examiner interprets information, such as, input borrower, property and originator date as the information relating to a domestic relation order claimed.

⁸ Wherein the file, specifically, the worker compensation and loan completion report correspond to the assembled domestic relations order claimed.

Regarding Claim 15, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method wherein the electronic communications network is one of a local area network, a wide area network, a telephone network, an intranet, or the Internet, or any other combination thereof (Figure 1, item 100, typical internet network configuration, Page 8, [0116], lines 1 – 7, Broadbent).

Regarding Claim 16, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising receiving the requested information through an online questionnaire (Figure, 15, Page 5, [0061], lines 5 – 10, Broadbent).

Regarding Claim 17, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising receiving at least a subset of the requested information from a previously completed domestic relations order (Page 13, [0177], lines 8 – 13, the previous 'override' application, Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay).

Regarding Claim 18, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising receiving at least a subset of the requested information associated with a participant in an employee benefit plan (Page 7, [0096], lines 7 – 9, employment agreement, Broadbent; and Page 1, [0008], lines 8 – 13, Esposito).

Regarding Claim 19, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method wherein the employee benefit plan comprises a defined contribution plan and a defined benefit plan, or both (Page 7, [0096], lines 7 – 9, employment agreement, Broadbent; and Page 1, [0008], lines 8 – 13, Esposito).

Regarding Claim 20, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising receiving a subset of the requested information associated with a legal representative of a participant in an employee benefit plan (Figure 30, “Welcome, Joe Realtor”, Page 7, [0097], lines 1 – 7, Broadbent ;and also see Page 7, [0094], lines 9 – 16, “(5) document preparation fee payable to the lender and passed through to third-party vendor; (6) tax related service fee payable to the lender and passed through to third-party vendor; and (7) attorney fee payable to lender and passed through to closing attorney. Applicants will charge a lender a membership fee to participate in Applicant's Program and a flat fee for each Completion Certificate issued to the lender.”; Broadbent).

Regarding Claim 21, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising receiving a subset of the requested information from an alternate payee of an employee benefit plan (Figure 22, “Married to (which co-borrower)”, Broadbent).

Regarding Claim 22, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising receiving at least a subset of the requested information associated with a legal representative of the alternate payee of an employee benefit plan (Figure 30, Page 7, [0097], lines 1 – 7, Broadbent ;and also see Page 7, [0094], lines 9 – 16, “(5) document preparation fee payable to the lender and passed through to third-party vendor; (6) tax related service fee payable to the lender and passed through to third-party vendor; and (7) attorney fee payable to lender and passed through to closing attorney. Applicants will charge a lender a membership fee to participate in Applicant's Program and a flat fee for each Completion Certificate issued to the lender.”; Broadbent).

Regarding Claim 23, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising providing a set of rules relating to the generating a domestic relations order (Page 4 and 16, [0051] and [0202], lines 1 – 6 and 1 – 3; respectively, Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay).

Regarding Claim 24, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method wherein automatically assembly the court-compliant domestic order comprises determining the subset of the sample text passages based, at least in part, on the rules (Page 9, [0120], lines 10 – 17, Broadbent;

Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay; and Page 1, [0008], lines 8 – 13, Esposito).

Regarding Claim 26, the combination of Broadbent in view of Fay and further in view of Esposito discloses a computerized system for producing a domestic relations order, comprising:

means for storing sample text passages for inclusion into a domestic relations order, the sample text passages including embedded parameters (Figure 5 and 22, item 543 and “save” in Figure 22, Page 20, [0219], lines 17 – 22; respectively, Broadbent⁹; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay) comprising an alternate payee Figure 22, “Married to (which co-borrower)”, Broadbent) and court information (Page 1, [0008], lines 5 – 7 and 21 – 29; Esposito);

means for receiving information about a first domestic relations order (Figure 24, Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay), the information providing values for one or more of the embedded parameters (Figure 24, item showing value “\$15000”, Page 21, [0238], lines 1 – 3, Broadbent¹⁰); and

means for automatically assembling court-compliant domestic relations order (Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay) for submission to a court using a first subset of the sample text passages (Page 9, [0120],

⁹ Wherein “First Name”, “Last Name”, etc correspond to the embedded parameters claimed.

¹⁰ Wherein the value “\$1500” corresponds to the value claimed; and “Estimated Property Value” corresponds to the parameter claimed.

lines 10 – 17, Broadbent; and Page 6, [0068], lines 14 – 25, Esposito) and a second subset of the received information (Figure 4D, items 482 and 483, Page 10, [0125] and [0126], lines 14 – 17 and 18 – 21; respectively, Broadbent¹¹; and Page 1, [0008], lines 8 – 13, Esposito).

Regarding Claim 28, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method further comprising determining one or more questions for the online questionnaire based on a rules engine and a subset of the requested information (Page 5, [0061], lines 5 – 10, Broadbent).

Regarding Claim 29, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method wherein assembling comprises using a document template (Page 7, [0073], lines 12 – 20, Esposito).

Regarding Claim 30, the combination of Broadbent in view of Fay and further in view of Esposito discloses a method wherein automatically assembling the court-compliant domestic relations order comprises using a subset of the requested information as input for one or more parameter fields of the document template (Page 9, [0120], lines 10 – 17, Broadbent; Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8; respectively, Fay; and Page 6, [0068], lines 14 – 25, Esposito).

¹¹ Wherein the file, specifically, the worker compensation and loan completion report correspond to the

Regarding Claim 31, the combination of Broadbent in view of Fay and further in view of Esposito discloses a system wherein the court-compliant domestic relations order is assembled according to one or more predefined document formats (Page 26, [0280], lines 14 – 26, Broadbent; and Page 3, [0037], lines 1 – 8, Esposito).

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broadbent et al. (Broadbent hereinafter) (US Patent App. Pub. 2001/0047326 A1, published: November 29, 2001), in view of Fay et al. (Fay hereinafter) (US Patent App. Pub. 2002/0188540 A1, filed: June 8, 2001), in view Esposito (US Patent App. Pub. No. 2001/0051906 A1, filed May 1, 2001), and further in view of Cohen et al. (Cohen hereinafter) (US Patent App. Pub. No. 2004/0064404 A1, filed: October 1, 2002).

Regarding Claim 27, the combination of Broadbent in view of Fay and further in view of Esposito discloses all the limitations as discussed above including court information. However, the combination of Broadbent in view of Fay and further in view of Esposito is silent with respect to a case number. On the other hand, Cohen discloses court information and a case number (Page 4, [0042], lines 1 – 8, Cohen).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Cohen's teachings to the system of the combination of Broadbent in view of Fay and further in view of Esposito. Skilled artisan

would have been motivated to do so, as suggested by Cohen (Page 4, [0042], lines 4 – 8, Cohen), to provide specific data about a case. In addition, the applied references (Broadbent, Fay, Esposito, and Cohen) teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, databases management systems, court information. This close relation between the applied references highly suggests an expectation of success.

(10) Response to Argument

A. Rejection under 35 U.S.C. § 103(a) over Broadbent et al. US Patent App. Pub. 2001/0047326 A1, in view of Fay et al. US Patent App. 2002/0188540 A1, and further in view of Esposito US Patent App. Pub. 2001/0051906.

a. Group I - Claims 1, 13, 26 (dependant claims 2, 7, 12, 14, 15, 16, 18, 19, 21, 28, 29)

Appellant argues that; “the combination of Broadbent, Fay and/or Esposito does not teach producing a Domestic Relation Order as claimed”

Examiner respectfully disagrees. First, in response to appellant's arguments, the recitation “producing a Domestic Relation Order” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to

stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Second, in response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the specific features upon which appellant relies (i.e., "...using particular inputs to produce a DRO...", "...the destination of an output document that will be generated or its third party beneficiary...", and "the DROs can be printed and submitted to the proper court") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Third, in response to appellant's argument that the applied art fails to disclose "a receiver for receiving information relating to a domestic relation order, said information comprising an alternate payee and court information", the arguments were fully considered but were not deemed persuasive. The combination of Broadbent in view of Fay and further in view of Esposito (Broadbent/Fay/Esposito hereinafter) does disclose: a receiver for receiving information relating to a domestic relation order (Figure 4A, item 401, Page 9, [0123], lines 3 – 8, "Original inputs from a lender/loan originator come into the system 401 through the `Loan Origination Gateway` (451 in FIG. 4C) or portal, which serves as an `entry point` or gateway to the `pipeline` or system for loan originator data and borrower data. The loan originator data 403 is used as input data to an authentication module (453 in FIG. 4C) to verify the lender/loan originator's ID and password"; wherein the step of inputting data corresponds to the step of receiving

information as claimed; Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8, "... receiving as an input two of a retirement date, a minimum retirement income amount and a defined premium payment amount for payment at each of a plurality of preset payment intervals; and calculating the other one of the retirement date...", and "...In one embodiment, the form of the VIA may be changed in relation to legal marriages and qualified domestic relation orders (QDROs) relating to the user. These changes may include 1) a single user/annuitant may be allowed to add a spouse to the VIA if the marriage occurs after the contract start date, in which case the benefit may be recalculated..."; wherein the input including a retirement date, retirement income amount and premium payment amount corresponds to information related to a domestic relation order; respectively, Fay), said information comprising an alternate payee (Figure 22, "Married to (which co-borrower)", Broadbent) and court information (Page 1, [0008], lines 1 – 7 and 21 – 29; "...The invention provides a method and apparatus for providing timely generation and transmission, reporting, monitoring, re-creation of documents using an event-triggered, Internet or automated-based system (e.g., Intranet, local and wide area networks (LAN/WAN)), such that the system is compliant with all federal, fiduciary, and administrative mandates imposed on an employee benefit sponsor...", and "...As such, human error is virtually eliminated; audit/legal exposure is lessened and expenses are controlled; potential penalties assessed by a federal court or government agency for non-compliance can be avoided; HR professionals are freed up to focus on other critical business tasks; upwardly

spiraling printing, delivering, and document storage costs are contained; and employee morale and satisfaction is improved...”, Esposito).

Appellant argues that; “the combination of Broadbent, Fay and/or Esposito does not teach court-compliance”

First, in response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the specific features upon which appellant relies (i.e., “...generating a document that is ...”, “...that govern the format for generating a DRO to be reviewed by the court”, and “...how to generate a DRO for court...”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, Broadbent/Fay/Esposito does disclose the limitation including: court-compliance (Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8, “... receiving as an input two of a retirement date, a minimum retirement income amount and a defined premium payment amount for payment at each of a plurality of preset payment intervals; and calculating the other one of the retirement date...”, and “...In one embodiment, the form of the VIA may be changed in relation to legal marriages and qualified domestic relation orders (QDROs) relating to the user. These changes may include 1) a single user/annuitant may be allowed to add a spouse to the VIA if the marriage occurs after the contract start date, in which case the benefit may be recalculated...”; Fay; and Page 1, [0008], “...One embodiment of the invention is a system that complies with reporting

and disclosure requirements for employee benefit plans, e.g., ERISA, IRS, other federal law and state...since it offers simplified compliance with federal and state rules...human error is virtually eliminated; audit/legal exposure is lessened and expenses are controlled; potential penalties assessed by a federal court or government agency for non-compliance can be avoided...”, Esposito). Furthermore, the Examiner interprets since the applied art (specifically Esposito) discloses compliance with federal and state laws and mechanisms for avoidance of potential penalties assessed by a federal court or government agency for non-compliance, then the applied art teaches court-compliance as claimed.

Appellant argues that; “the combination of Broadbent, Fay and/or Esposito does not teach the use of court information”

First, in response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the specific features upon which appellant relies (i.e., “...the use of court ...”, and “would be the needed information to be used by...to generate a court-compliant DRO”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, Broadbent/Fay/Esposito does disclose court information (Page 1, [0008], lines 1 – 7 and 21 – 29; “...The invention provides a method and apparatus for providing timely generation and transmission, reporting, monitoring, re-creation of

documents using an event-triggered, Internet or automated-based system (e.g., Intranet, local and wide area networks (LAN/WAN)), such that the system is compliant with all federal, fiduciary, and administrative mandates imposed on an employee benefit sponsor...”, and “...As such, human error is virtually eliminated; audit/legal exposure is lessened and expenses are controlled; potential penalties assessed by a federal court or government agency for non-compliance can be avoided; HR professionals are freed up to focus on other critical business tasks; upwardly spiraling printing, delivering, and document storage costs are contained; and employee morale and satisfaction is improved...”, Esposito). Furthermore, the Examiner interprets since the applied art (specifically Esposito) discloses avoidance of potential penalties assessed by a federal court or government agency for non-compliance, then the applied art teaches court-information as claimed. Also, Examiner points out that in order to comply with federal court, there have to be court information involved.

Appellant argues that; “the combination of Broadbent, Fay and/or Esposito does not teach document preparation for submission to a court”

First, in response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the specific features upon which appellant relies (i.e., “...preparation”, and “preparing a document...”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, appellant seems to direct his arguments towards step of: "submitting a document". However, the claims only recite "a domestic relations order for submission to a court". The Examiner notes that limitation "for submission..." as recited is a statement for intended use or field of use.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04. USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the

claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

The Examiner has given the claims their broadest reasonable interpretation in light of the specification of the disclosure but without importing limitations from the specification into the claims. Therefore, since the applied art teaches: avoidance of penalties assessed by a court for non-compliance (Page 1, [0008], lines 1 – 7 and 21 – 29; "...As such, human error is virtually eliminated; audit/legal exposure is lessened and expenses are controlled; potential penalties assessed by a federal court or government agency for non-compliance can be avoided; HR professionals are freed up to focus on other critical business tasks; upwardly spiraling printing, delivering, and document storage costs are contained; and employee morale and satisfaction is improved...", Esposito) then the document will be submitted to a court. Thus, it teaches the claimed limitation "for submission to a court".

b. Group II – Claims 3, 5, 20, 22

Appellant argues that: "the combination of Broadbent, Fay and/or Esposito does not teach using legal representative information"

First, appellant argues that the applied art fails to disclose "using legal representative information" and further "does not show a legal representative". However, the claims only recite "information associated with a legal representative of the participant". Examiner notes that "information associated with a legal representative" is not the same as "a legal representative". As discussed in this Office Action above, the Examiner has given the claims their broadest reasonable

interpretation in light of the specification of the disclosure but without importing limitations from the specification into the claims.

Second, the applied art does disclose the claimed limitation: information associated with a legal representative (Figure 30, “Welcome, Joe Realtor”, Page 7, [0097], lines 1 – 7, Broadbent ;and also see Page 7, [0094], lines 9 – 16, “(5) document preparation fee payable to the lender and passed through to third-party vendor; (6) tax related service fee payable to the lender and passed through to third-party vendor; and (7) attorney fee payable to lender and passed through to closing attorney. Applicants will charge a lender a membership fee to participate in Applicant's Program and a flat fee for each Completion Certificate issued to the lender.”; Broadbent)

c. Group III – Claims 6, 8, 9, 10, 11, 17, 23, 24, and 31

Appellant argues that; “the combination of Broadbent, Fay and/or Esposito does not teach rules or information related to DROs”

First, in response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the specific features upon which appellant relies (i.e., “...rules for the formatting...”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, the applied art does disclose the limitation: rules relating to a domestic relations order (Page 4 and 16, [0051] and [0202], lines 1 – 6 and 1 – 3, “...Automated

Compliance Engine (the "Compliance Engine") which is designed to maintain and use a rules-based loan compliance database to generate the set of tasks required to be performed to complete and close a specific mortgage loan transaction...", and "At startup, the Automated Compliance Engine reads the XML-formatted `rules` from external storage into memory. This XML stream is parsed by the JAXP parser into a DOM internal tree. For each `rules.operations.task`..."; respectively, Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8, "In one embodiment, the form of the VIA may be changed in relation to legal marriages and qualified domestic relation orders (QDROs) relating to the user. These changes may include 1) a single user/annuitant may be allowed to add a spouse to the VIA if the marriage occurs after the contract start date, in which case the benefit may be recalculated; and 2) if the spousal joint owner/annuitants get divorced after issue and the contract is split by a QDRO..."; respectively, Fay).

B. Rejection under 35 U.S.C. § 103(a) over Broadbent et al. US Patent App. Pub. 2001/0047326 A1, in view of Fay et al. US Patent App. 2002/0188540 A1, in view of Esposito US Patent App. Pub. 2001/0051906, and further in view of Cohen et al. US Patent App. Pub. 2004/0064404 A1.

a. Group I – Claim 27

Appellant argues that; “the combination of Broadbent, Fay, Esposito, and/or Cohen does not teach the use of court information

Examiner respectfully disagrees. The combination of Broadbent in view of Fay, in view of Esposito, and further in view of Cohen does disclose court information (Figure 4A, item 401, Page 9, [0123], lines 3 – 8, “Original inputs from a lender/loan originator come into the system 401 through the ‘Loan Origination Gateway’ (451 in FIG. 4C) or portal, which serves as an ‘entry point’ or gateway to the ‘pipeline’ or system for loan originator data and borrower data. The loan originator data 403 is used as input data to an authentication module (453 in FIG. 4C) to verify the lender/loan originator’s ID and password”; Broadbent; and Page 2 and 8, [0015] and [0077], lines 1 – 6 and 1 – 8, “... receiving as an input two of a retirement date, a minimum retirement income amount and a defined premium payment amount for payment at each of a plurality of preset payment intervals; and calculating the other one of the retirement date...”, and “...In one embodiment, the form of the VIA may be changed in relation to legal marriages and qualified domestic relation orders (QDROs) relating to the user. These changes may include 1) a single user/annuitant may be allowed to add a spouse

to the VIA if the marriage occurs after the contract start date, in which case the benefit may be recalculated...”; respectively, Fay; and Page 4, [0042], lines 1 – 8, Cohen).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Giovanna Colan/

Examiner, Art Unit 2162

Conferees:

/John Breene/

Supervisory Patent Examiner, Art Unit 2162

/Mohammad Ali/

Supervisory Patent Examiner, Art Unit 2158

An appeal conference was held on 03 December 2005, and it was agreed to proceed to the board of appeals.